

### **RESPONSE TO REJECTIONS UNDER 35 U.S.C. §103**

In order for a claim to be properly rejected under 35 U.S.C. §103, the combined teachings of the prior art references must suggest all features of the claimed invention to one of ordinary skill in the art. See, e.g., *In Re Dow Chemical*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988), and *In re Keller*, 208 U.S.P.Q. 871, 881 (C.C.P.A. 1981). In addition, “(t)he PTO has the burden under section 103 to establish a *prima facie* case of obviousness.” *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Furthermore, the Federal Circuit has stated that “(i)t is impermissible, however, to simply engage in hindsight reconstruction of the claimed invention, using the applicant’s structure as a template and selecting elements from references to fill the gaps.” *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d 1885 (1991).

#### **Claim 1**

Claim 1 is not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Claim 1 reads as follows:

1. A method for printing information comprising:  
***storing information corresponding to a print task in memory in a print-ready format, such that information in the print-ready format can be printed by a printing device without being processed by a driver; and***  
***enabling a selected portion of the information in the print-ready format to be printed without printing a non-selected portion of the information in the print-ready format.*** (Emphasis added).

Applicant respectfully asserts that the cited art is inadequate to render pending claim 1 obvious. In particular, the cited art fails to suggest or teach at least the features of pending claim 1 highlighted hereinabove.

The Office Action states “*Mori* teaches a print system and printer comprising...[a] job retention system configured to store print-ready information corresponding to a print task,”

citing column 3, lines 2-5 and 19-20 as support for this statement. However, *Mori* specifically reads:

“As shown in FIG. 2, the computer 20 is provided with several application programs 41 for creating **print data**; a printer driver 42 for converting the print data to a format supported by the printer and for transmitting the converted data to the printer 10.”

(Emphasis added) See *Mori*, column 3, lines 2-5. Thus, it appears that *Mori* teaches that the print data transmitted is data that has been converted into a format supported by the printer to which it is being transmitted. In this regard, the printer driver of the computer converts the data and transmits the converted data, i.e., the **print data**.

Further, *Mori* specifically reads:

“As shown in FIG. 3, the printer control portion 31 of the printer 10 is constructed from: a CPU 11 for controlling the entire printer 10; a ROM 12 used to store various control programs such as a main control program and print programs (printer controller 31) shown in FIGS. 7 and 8; a RAM 13 including various buffers for temporarily storing **print data** transmitted from the computer 20 and storing a printer job management table T2...”

(Emphasis added) See *Mori*, column 3, lines 14-21. Thus, in *Mori* it appears that when the **print data** is received by the printer, the print data received is stored in the RAM, as indicated.

In addition to these cited teachings, *Mori* also reads that the system comprises

“a **print data** retransmission request means for requesting retransmission of the print data desired to be reprinted after the print performing means has printed the print data; and a computer including: transmission means for transmitting the **print data** to the printer so that the printer will print the **print data**...”

(Emphasis added ) See *Mori*, column 1, lines 62-65. In this regard, the computer stores print data in memory resident on the computer and the requested print data is selected from the print data stored on the computer and is resent to the printer 10 for reprinting. ”

Specifically, *Mori* teaches that the **print data** is in a format supported by the printer to which the data is transmitted. However, *Mori* states that this “print data” is the data that is stored in the RAM 13. Such “print data” stored in “temporary buffers” of RAM 13 is further addressed in column 3, lines 30-32 wherein *Mori* teaches “that the printer 10 is of a type that can store, in the RAM 13, the last page of print data (job) printed last onto a predetermined type of sheet,” and

“if the received data is determined...to be **print data**...the CPU 11 first separates... the print data into: management data such as header data and the like; and print data body for performing actual printing. The CPU 11 then performs a normal printing control operation with controlling the driver circuit 15 with the print data body.”

See *Mori*, column 8, lines 36-40

Notably, the “print data” in *Mori* is not in “print-ready format.” To the contrary, upon determination by the printer that retransmitted data is to be printed, the data is to be separated “for actual printing.” Hence, it appears that the “print data” stored in RAM cannot be in print-ready format, because *Mori* explicitly teaches that operations on the print data must be performed prior to the **print data** being ready to print.

Furthermore, the Office Action states that “*Mori* does not specifically teach ...[a] job retention system... configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.” See Office Action, page 2. However, the Office Action asserts that *Housel* does teach a printing system exhibiting this feature, and Applicant respectfully traverses this assertion.

Generally, *Housel* appears to teach a printing system that permits a user to select portions of a print task to be printed on selected mediums. However, it does not appear that the print task is “information in print-ready format.” To the contrary, *Housel* specifically teaches allowing a user to select print task pages and associated mediums at the printer interface, and **thereafter**, the “central

processing unit 17 converts the information ...into printer-readable language for the printer.” See *Housel*, paragraph 52, lines 5-10.

Therefore, it does not appear that the alleged combination teaches or suggests “enabling a selected portion of the **information in the print-ready format** to be printed without printing a non-selected portion of the information in the print-ready format,” as claimed in claim 1. (Emphasis added).

Accordingly, Applicant submits that the Office Action fails to overcome its burden of establishing that each of the features in the combination highlighted hereinabove for claim 1 is suggested or taught by the cited art.

For at least the foregoing reasons, Applicant submits that the 35 U.S.C. §103 rejection of claim 1 is improper and should be withdrawn.

### **No Motivation to Combine**

In addition, in rejecting pending claim 1, it is asserted in the Office Action that:

“[I]t would have been obvious to one having ordinary skill in the art to modify *Mori* to permit portions of the print-ready information to be selected and printed since *Housel et al.* teaches that enabling a selected portion of a print job to be printed is beneficial for permitting a user to more easily designate the print jobs.”

However, Applicant respectfully asserts that this alleged motivation for combining *Mori* with *Housel* is inadequate.

In this regard, the Office Action fails to cite a specific teaching in the cited art showing that the alleged motivation for combining *Mori* with *Housel* is suggested by the cited art. “There must be some reason, suggestion, or motivation *in the prior art* whereby a person of ordinary skill in the field of the invention would make the combination.” *In re Oetiker*, 977 F.2d 1443, 1447, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992)(emphasis added).

Applicant submits that the aforementioned reason proffered in the Office Action for combining *Mori* with *Housel* is not gleaned from the cited art but is instead based on improper hindsight reconstruction of Applicant's invention. In this regard, *Mori* does not teach that "a printer driver that converts the print data into information in print-ready-format, as suggested by the Office Action. As argued hereinabove, it appears that the data created by the application programs in *Mori* is converted into a format that is supported by the printer, however, the printer receives the print data and converts the print data into print-ready information. See *Mori*, column 3, lines 2-5; column 3, lines 14-29.

Thus, when the system of *Mori* is combined with House, the combination is a printing system that stores print data in memory on a computer, and the printer system enables a user to select portions of the print data for printing to the printer device. However, the portion selected is not in print ready format.

As a result, the combination of *Mori* and *Housel* to reject pending claim 1 under 35 U.S.C. §103 is improper.

#### **Claims 2-9 and 21-29**

Claims 2-9 and 21-29 are no unpatentable under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claims 2-9 and 21-29 contain all features of their respective independent claim 1. Since claim 1 should be allowed, as argued hereinabove, pending dependent claims 2-9 and 21-29 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

**Claim 10**

Claim 10 is not unpatentable under 35 U.S.C. §103 over *Mori* in view of *Housel*. Previously presented claim 10 reads as follows:

10. A print system comprising:  
 a job retention system configured to *store print-ready information corresponding to a print task and to receive an input corresponding to a selected portion of the print-ready information, the print-ready information being configured for use by a printing device such that the information can be printed by the printing device without being processed by a driver of the printing device*, the job retention system being further configured *to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information*. (Emphasis added).

For at least the reasons set forth hereinabove in the arguments for allowance of claim 1, Applicant submits that the cited art fails to suggest or teach at least the features of claim 10 highlighted hereinabove. Therefore, the 35 U.S.C. §103 rejection of claim 10 is improper and should be withdrawn.

**Claims 12-20 and 30**

Claims 12-20 and 30 are not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claims 12-20 and 30 contain all features of their respective independent claim 10. Since claim 10 should be allowed, as argued hereinabove, pending dependent claims 12-20 and 30 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

### **Claim 31**

Claim 31 is not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Claim 31 reads as follows:

31. A system, comprising:  
a printing device having an input interface; and  
*a job retention system configured to receive and store print-ready information corresponding to a print task, the job retention system further configured to receive selection information from a user, via the input interface, and configured to select a portion of the print-ready information based upon the selection information, the job retention system further configured to enable the selected portion of the print-ready information to be printed without printing a non-selected portion of the print-ready information.*

Applicant asserts that the cited art fails to disclose or teach each of the above features of claim 31.

Thus, claim 31 is allowable.

### **Claims 32**

Claim 32 is not obvious under 35 U.S.C. §103 over *Mori* in view of *Housel*. Applicant submits that the pending dependent claim 32 contains all features of its respective independent claim 31. Since claim 31 should be allowed, as argued hereinabove, pending dependent claim 32 should be allowed as a matter of law for at least this reason. *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

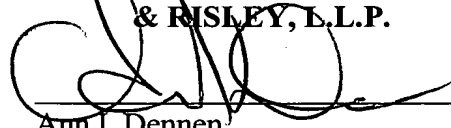
**CONCLUSION**

Applicant respectfully requests that all outstanding objections and rejections be withdrawn and that this application and all presently pending claims be allowed to issue. If the Examiner has any questions or comments regarding Applicant's response, the Examiner is encouraged to telephone Applicant's undersigned counsel.

Respectfully submitted ,

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